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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,188	07/02/2002	Dov Moran	10519/1167 (MSA-0019-2-US)	4688
67813 7590 07/22/2009 BRINKS HOFER GILSON & LIONE/SanDisk P.O. BOX 10395 CHICAGO, IL 60610			EXAMINER TINKLER, MURIEL S	
			ART UNIT 3691	PAPER NUMBER
			MAIL DATE 07/22/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/089,188	Applicant(s) MORAN ET AL.	
	Examiner MURIEL TINKLER	Art Unit 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☒ Claim(s) 1 and 2 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/26/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This application has been reviewed. The status of the claims are as follows: claims 1-50 were previously pending; claims 18-41 and 43-50 were previously withdrawn; no claims have been added or amended; claims 18-50 have been cancelled; therefore, claims 1-17 are currently pending and have been examined.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 26, 2009 has been entered.

Response to Arguments

1. Applicant's arguments, see page 5, filed June 26, 2009, with respect to the 35 USC 102 and 35 USC 103 rejections of claims 1-17 have been fully considered and are persuasive. The Applicant filed an Application Data Sheet on March 27, 2002 citing the Moran reference. The 35 USC 102 and 35 USC 103 of claims 1-17 has been withdrawn.

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2. Applicant's arguments filed June 26, 2009, regarding the Double Patenting Reference and allowable subject matter have been fully considered but they are not persuasive.

a. Regarding the argument against the Double Patenting Rejection. The Examiner stated in the Office Action mailed on January 26, 2009 that the Double Patenting rejection would be withdrawn with a properly filed terminal disclaimer. There is no record of a terminal disclaimer being filed in this case.

b. Regarding the argument that the claims are allowable: The Examiner did not agree to allowable claim language nor was there any mention of allowable subject matter in the Office Action mailed on January 26, 2009. There was only a statement that the prior art rejections using the cited references would be withdrawn. The Examiner can not, and has not, render any opinion on allowability without performing a further search.

3. Applicant's arguments, see page 5, filed June 26, 2009, with respect to the rejection(s) of claim(s) 1-17 under 35 USC 102 and 35 USC 103 have been fully considered and are persuasive. An Application data sheet has been filed that links the Moran reference to this application. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Gullman et al. (US 5,280,527) in view of Helland et al. (US 6,014,666) over claims 1-9, 12 and 14-17 and in further view of Pare et al. (US 5,805,719) over claims 10, 11 and 13.

Double Patenting

4. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

5. A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

6. Claim 42 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 14 of prior U.S. Patent No. 6,324,537 and claim 18 of prior U.S. Patent No. 6,539,3807. This is a double patenting rejection.

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated

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by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

8. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

9. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 11 of U.S. Patent No. 6,324,573 and claim 11 of U.S. Patent No. 6,539,380. Although the conflicting claims are not identical, they are not patentably distinct from each other because they cover the same content.

Claim Objections

11. Claims 1 and 2 are objected to because of the following informalities: both claims 1 and 2 use acronyms without additional definitions. More specifically: claim 1

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uses the acronym USB; and, claim 2 uses the acronym ASIC. Appropriate correction is required.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claim 1-9, 12 and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gullman et al. (US 5,280,527) in view of Helland et al. (US 6,014,666), hereafter referred to as Gullman and Helland.

15. Regarding claim 1, Gullman discloses:

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- a. A device for controlling access to a resource, access being provided through a host device, the device (see Abstract)
- b. an input for receiving a request to access the resource (figure 1 #14—biometric security sensor); and,
- c. a processor for executing said at least one instruction and for comparing said request to said at least one permission, such that if said at least one permission includes a type of access requested in said request, access to the resource is provided, and alternatively if said at least one permission does not include a type of access requested in said request, access to the resource is not provided (see figure 2 #22—processor);

16. Gullman does not disclose a USB and a USB interface controller for communicating with the USB bus of the host device and, if permitted, for transmitting data from said processor; a flash memory device for storing at least one permission for determining access to the resource; and, a flash memory controller for controlling said flash memory device. Helland discloses these things in column 5 (line 55) through column 6 (line 5) and column 6 (lines 13-27). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Gullman to include the use of flash memory and universal serial bus because both flash and universal serial bus were well known in the art as storage and connectivity options at the time the invention was made.

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17. Regarding claim 2, Gullman discloses: The device of claim 1, wherein the device is implemented as a programmable ASIC [integrated circuit (Abstract) programmed for a particular use (figure 3); see also column 4 (lines 39-49).

18. Regarding claim 3, Gullman discloses: The device of claim 1, wherein access is determined according to a biological parameter of a user, the device further comprising a biometric detection device for detecting said biological parameter of the user and for determining whether the user has said at least one permission to access the stored data, said biometric detection device being connected to said processor (see figure 1 #14).

19. Regarding claim 4, Gullman discloses: The device of claim 3, wherein said biometric detection device further comprises: (i) a sample collector for collecting said biological parameter of the user; and (ii) a software module for analyzing said biological parameter to determine whether the user has said at least one permission to access the resource (see column 3 (lines 36-55)).

20. Regarding claim 5, Gullman discloses: The device of claim 4, wherein said biometric detection device further comprises: (iii) a memory device for storing said software module and at least one previously collected biological parameter of the user; and (iv) a data processor for operating said software module (see processor with RAM, figure 2 #33).

21. Regarding claim 6, Gullman discloses: The device of claim 5, wherein said biological parameter of the user is a fingerprint of the user (see column 3 (lines 36-55)).

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22. Regarding claim 7, Gullman discloses: The device of claim 1, further comprising:
(f) a RAM component for storing data for performing said at least one instruction of said data processor (see figure 2 #33).

23. Regarding claim 8, Gullman discloses: The device of claim 1, further comprising:
(f) a cryptographic chip for encrypting and decrypting data (see figure 3).

24. Regarding claim 9, Gullman discloses: The device of claim 8, wherein said cryptographic chip performs an authentication process (see column 4 (line 50) through column 5 (line 14) and column 5 (lines 34-39)).

25. Regarding claim 12. , Gullman discloses: The device of claim 8, wherein said cryptographic chip performs encryption immediately upon receiving a command from said data processor (real-time, see column 4 (line 50) through column 5 (line 14)).

26. Regarding claims 14 and 15, Gullman discloses: The device of claim 8, wherein said cryptographic chip further comprises a cryptographic chip memory for storing at least one cryptographic key and at least one cryptographic instruction for encrypting and decrypting data, such that said cryptographic chip forms a removable encryption engine; wherein said encrypted data is stored on said cryptographic chip memory (see figure 2 #33).

27. Regarding claims 17, Gullan discloses: the device of claim 15, wherein said cryptographic chip memory is said flash memory device (see the rejection of claim 1 above).

28. Regarding claim 16, The Examiner argues that it would be obvious make something separate that is currently combined (see the rejection of claim 17 above).

29. Claims 10, 11 and 13 rejected under 35 U.S.C. 103(a) as being unpatentable over Gullman and Helland as applied to claims 8 and 12 above, and further in view of Pare et al. (US 5,805,719), hereafter referred to as Pare.

30. Regarding claims 10 and 11, Gullman and Helland disclose the information in claim 8. Gullman and Helland do not disclose that said cryptographic chip emulates a smart card and stores encrypted smart card data. Pare discloses this in column 2 (line 24) through column 3 (line 14). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Gullman and Helland to include the use of a smart card and encrypted smart card data because it is a current was an increasing trend in the banking industry at the time of this invention and it provides an efficient way to store information.

31. Regarding claim 13, Gullman and Helland disclose the information in claim 12. Gullman and Helland do not disclose that said cryptographic chip creates a cryptographic signature with a hash immediately upon receiving a command from said data processor. Pare discloses the use of a hash algorithm in column 62 (line 62) through column 63 (line 10). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Gullman and Helland to include a hash algorithm because it provides further security for data that may travel through an un-secure network.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MURIEL TINKLER whose telephone number is (571)272-7976. The examiner can normally be reached on Monday through Friday from 6:30 AM until 3 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571)272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. T./
Examiner, Art Unit 3691

/Hani M. Kazimi/
Primary Examiner, Art Unit 3691